

priority back to provisional application, filed October 23, 1998. Applicants respectfully contend that U.S. 6,403,597 (hereinafter "597 patent") is *not* § 102(e) art against Applicants' invention. In particular, the '597 patent (continuation-in-part application, 09/888,250, filed 06/21/01; claiming priority to continuation-in-part application, 09/467,094, filed 12/10/99, claiming priority to U.S. application 09/181,070, filed 10/27/98) is not entitled to the priority filing date of its parent application, 09/181,070 (filed 10/27/98; now U.S. 6,037,346 (hereinafter "'070 application")), for § 102(e) purposes.

In order to carry back the 35 U.S.C. § 102(e) critical date of the U.S. patent reference to the filing date of the parent application, the parent application must . . . (B) support the invention claimed as required by 35 U.S.C. § 112, first paragraph. "For if a patent could not theoretically have issued the day the application was filed, it is not entitled to be used against another as 'secret prior art'" under 35 U.S.C. § 102(e).

MPEP § 2136.03 (IV) (citing In re Wertheim, 646 F.2d 527, 537).

The parent '070 application does not support the invention claimed in the continuation-in-part '597 patent as required by 35 U.S.C. § 112, first paragraph. In particular, the specific disclosure of solid delayed release dosage forms, cited by the Examiner as § 102(e) art, *is not supported* by the parent '070 application. The '070 application merely refers to general solid compositions for the treatment of erectile dysfunction via local administration to avoid side-effects associated with systemic "oral" administration, but does not disclose *solid delayed release* dosage forms. (Col.2, lines 53-60; col. 4, lines 1-10). There is no specific disclosure in the '346 patent of tablets (Col. 9; lines 23-29) and no discussion of modified release dosing (Col. 14, lines 4-25). The disclosure of the '070 application, therefore, does not support the invention of the '597 patent.

Furthermore, Applicants note that the inventors of the parent '070 application are different from the cited '597 patent. This suggests that the subject matter of the continuation-in-part '597 patent is different matter, with different inventors, from that of the original '070 parent application.

Consequently, the '597 patent is not entitled to the filing date of the '070 application. At best, the '597 patent's critical § 102(e) date is no earlier than December 10, 1999 (and may very well be June 21, 2001). On the other hand, Applicants' application claims priority back to, *inter alia*, the U.S. provisional application filing date of October 23, 1998 and U.S. non-provisional filing date of October 22, 1999.

In light of the above, Applicants respectfully request reconsideration of the rejection of Claims 31, 33-35, 46-51, 54, 55 and 58. The objection to Claims 38-43 is rendered moot upon favorable reconsideration of the above.

CONCLUSION

In view of the foregoing comments, it is respectfully submitted that this application is in condition for allowance. A Notice of allowance is respectfully requested.

Respectfully submitted,

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Pfizer Inc.  
Patent Department, MS 8260-1611  
Eastern Point Road  
Groton, Connecticut 06340  
(860) 715-4288

Martha G. Munchhof  
Martha G. Munchhof  
Attorney for Applicant(s)  
Reg. No. 47,811